REMARKS

Claims 1, 51, 100 and 136 have been amended. Claims 137 and 139 have been cancelled. Therefore, claims 1-24, 51-73, 100-117, 136 and 138 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Benefit of Priority:

The Examiner states that certain claim limitations (e.g. use of message passing model, a second device using a different message passing model, a proxy service generating a results advertisement, publishing an advertisement, generation of a results method gate from a results advertisement, and results advertisements being sent to a client method gate) are not disclosed in the provisional applications to which the instant application claims the benefit of priority. Applicants respectfully disagree with the Examiner and submit that claims of the current application are disclosed in each provisional application (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) to which the instant application claims the benefit of priority.

Additionally, the Examiner has the burden to present evidence or reasons why persons skilled in the art would not recognize support for the claim. *In re Wertheim*, 191 USPQ 90 (CCPA 1976). As stated by the Board of Patent Appeals & Interferences in *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (B.P.A.I. 1987), "a bare assertion by the Examiner" is insufficient for an assertion that a claim lacks support. The Examiner has not presented any reasons or evidence as to why persons skilled in the art would not recognize support for the current claims in the provisional applications to which the instant application claims the benefit of priority. Instead, the Examiner has merely asserted that certain claim limitations are not disclosed in the provisional applications.

Applicants also remind the Examiner that the subject matter of a claim need not be described literally in order for the disclosure to satisfy the description requirement for a priority claim. As repeatedly stated by the Board of Patent Appeals & Interferences and

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

22

by the Court of Appeals for the Federal Circuit, it is well settled law that the invention claimed [in the later application] does not have to be described [in the parent] *in ipsis verbis* in order to satisfy the requirements of §112. *Jacobs v. Lawson*, 214 USPQ 907, 910 (B.P.A.I. 1982).

Applicants note that the subject matter recited in the claims of the current application **is disclosed** in each provisional application (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) to which the instant application claims the benefit of priority. Furthermore, the specific subject matter referred to by the Examiner (i.e. use of message passing model, a second device using a different message passing model, a proxy service generating a results advertisement, publishing an advertisement, generation of a results method gate from a results advertisement, and results advertisements being sent to a client method gate) is disclosed in each provisional application (Serial No: 60/202,975, 60/208,011, 60/209,430, 60/209,140, 60/209,525) to which the instant application claims the benefit of priority.

For instance, the use of a message passing model, which the Examiner specifically asserts is not disclosed, is disclosed in provisional application 60/202,975. For example, pages 15 -18 provides an introduction to using a message passing model. Page 17, lines 14-26 states, "the foundation for the distributed computing environment is a simple message passing layer implemented on top of reliable connection and/or unreliable datagrams and goes on to describe how a message passing layer may support an asynchronous, stateless style of distributed programming and may be based on a data representation language, such as XML." Thus, the provision application clearly discloses the use of a message passing model, contrary to the Examiner's assertion.

The Examiner also contends that the provisional applications do not disclose a second device using a different message passing model. Applicants respectfully direct the Examiner to page 32, lines 22-27 that specifically describes providing a bridge and advertisements to services in environments that using different protocols (e.g. different message passing models).

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

23

Additionally, provisional application 09/202,975 clearly discloses storing service results in spaces, generating advertisements for the contents of a space, a proxy service for accessing a space, the publishing of advertisements and constructing gates from advertisements. For example, the use of a proxy service for accessing a space is described in provisional application 09/202,975 page 28, line 27 – page 29, line 4 and at page 29, line 24 – page 30, line 4, among other places. The use of advertisements in spaces is described, for example, at page 20, line 18 – page 22, line 17 and page 23, lines 2-16. The publishing of advertisements may be found, for example, at page 21, lines 9-18; page 36, lines 12-18; and page 43, lines 19-30. The generation and use of results is described at numerous places including (but not limited to) page 21, lines 20-26; page 23, lines 12-16; page 28, line 27 – page 29, line 4; Page 29, line 24 – page 30, line 9; and page 37, lines 12 - page 39, line 11. Constructing method gates from advertisements maybe found at page 24, line 18 – 28; page 25, lines 9-20; Page 25, line 22 – page 26, line 13; and page 34, line 27 – page 35, line 8.

Taken together the various descriptions and teachings of provisional application 09/202,975 clearly disclose the subject matter that the Examiner asserts it does not (e.g. proxy service generating results advertisements, publishing of advertisements, generating a method gate from a results advertisement, sending results advertisement to the client method gate). As the other provisional applications disclose subject matter including that included in provisional application 09/202,975 the other provisional application also disclose the features described above. Applicants' therefore assert that the present application is entitled to the claimed benefit of priority.

Section 102(e) Rejection:

The Office Action rejected claims 1-5, 19-21, 23, 24, 51-55, 68-70, 72, 73, 100-103, 113, 114, 116, 117 and 136-139 under 35 U.S.C. § 102(e) as being anticipated by Tuatini (U.S. Publication 2002/0032783). Applicants respectfully traverse this rejection for at least the following reasons.

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

24

Regarding claim 1, contrary to the Examiner's assertion, Tuatini fails to disclose the proxy service providing to the first entity an interface to a second entity in the second computing environment, wherein the proxy service appears to the first entity as the second entity. The Examiner cites paragraphs [0142-0144] of Tuatini that describe a specific example of a client application registering a user via a remote shared service named "UserRegistration". In this example, the client application sends a request message to a local messaging service to be forwarded to the remote shared service. However, nothing in the cited passage teaches that the local messaging service (which the Examiner equates to a proxy service) appears to the client application as the remote shared service. In fact, Tuatini teaches that the client application includes the name of the remote shared service in the message to the local messaging service.

Specifically, Tuatini states, "the message includes the logical name of the shared service, the logical name of the function, and a sub-message including parameter information for the function to be invoked (Tuatini, paragraph [0129]). Thus, the client application clearly sends a message to the local messaging service specifying the shared service to which the sub-message should be forwarded. Additionally, Table 4 on page 17 of Tuatini illustrates a sample message from the user registration example cited by the Examiner that includes the logical names of both the shared service ("UserRegistration") and the desired function ("create-user-profile").

Thus, Tuatini clearly does not teach wherein the proxy service appears to the first entity as the second entity. For at least the reasons above, the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Remarks similar to those above regarding claim 1 also apply to claims 51 and 100.

Regarding claim 136, neither Tuatini nor Beck teaches or suggests wherein the advertisement includes information describing one or more computer programming language method calls to methods in the computer programming language provided by the second entity, the method further comprising constructing on the first entity a client

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

25

method gate configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls.

The Examiner fails to cite any portion of either Tuatini or Beck describing constructing a client method gate on the first entity configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls described in the advertisement. The Examiner does not provide any remarks, arguments, not does the Examiner even mention any interpretation of Tuatini in view of Beck that teaches or suggests construction of such a client method gate. Instead, the Examiner merely rejects claim 136 as part of a single rejection of claims 6-12, citing FIG. 1 and the Abstract of Beck and stating only that Beck "discloses the use of advertisement[s] (e.g. Middleware enables a device to discover, advertise and use services." Thus, the Examiner has not provided a proper rejection of claim 136.

Additionally, Tuatini and Beck, either separately or in any combination, fail to teach or suggest constructing a client method gate on the first entity configured to provide an interface to the second entity. Instead, as the Examiner admits, Tuatini fails to mention anything regarding service advertisements. Also, Tuatini fails to teach or suggest constructing a client method gate. Beck teaches a system in which clients locate and use services based upon service descriptions in a service advertiser's registry (Beck, column 4, lines 31-39). However, Beck does not mention anything regarding a client constructing a client method gate configured to provide an interface to a service by generating data representation language messages including information representing the method calls described in an advertisement.

Thus, the Examiner's suggested combination of Tuatini and Beck fails to teach or suggest constructing on the first entity a client method gate configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls. Instead Tuatini in view of Beck

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

26

results in a system wherein the messaging component of Tuatini uses the service advertiser's registry of Beck to locate shared services.

For at least the reasons given above, the rejection of claim 136 is not supported by the cited prior art and removal thereof is respectfully requested.

Regarding claim 138, Tuatini does not disclose wherein providing an interface comprises sending to the first entity a schema defining one or more messages in the data representation language for accessing the second entity, in contrast to the Examiner's contention. The Examiner cites paragraphs [0166-0168] where Tuatini describes the use of an LDAP directory service. However, Tuatini does not teach sending a client application (which the examiner equates to a first entity) a schema defining one or more messages in the data representation language for accessing the second entity. Instead, Tuatini describes how a LDAP directory may include a schema defining objectclasses of information that can be stored in the directory entries. Tuatini does not mention anything about a schema define messages in a data representation language for accessing the LDAP directory service. Tuatini also fails to mention sending such a schema to a client application.

Furthermore, Tuatini teaches how a client accesses a LDAP directory by instantiating a directory manager object and uses method of the directory manager object to retrieve other objects (both directory entry objects and adapter objects) for accessing particular directory entries. (Tuatini, paragraph [0167]). Thus, Tuatini's system provides access objects for the entries of a LDAP directory service rather than sending a schema defining messages in a data representation language for accessing the directory service.

Thus, the rejection of claim 138 is not supported by the prior art and removal thereof is respectfully requested.

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

27

Furthermore, this rejection is improper because the Examiner has not shown that Tuatini qualifies as a prior art reference. The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that Tuatini qualifies as a prior art reference, the Examiner has not met this burden of proof and the rejection is improper. More specifically, the Tuatini patent was filed on January 2, 2001, <u>after</u> Applicants' filing date of October 19, 2000. Tuatini does claim the benefit of provisional applications filed December 30, 1999. However, the December 30, 1999 filing date can only be used as Tuatini's 35 U.S.C. § 102(e) prior art date for the subject matter that is common to both the Tuatini patent and the provisional applications. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application(s), it is unclear whether the material in Tuatini relied upon by the Examiner was actually present in Tuatini's provisional applications.

The Examiner has provided 50 pages of the Tuatini's provisional applications, but has failed to show that the subject matter on which the Examiner is relying on to reject Applicants' claims is present in Tuatini's provisional applications. As stated in 37 CFR 1.104(c)(2), "[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on **must** be designated as nearly as practicable." The Tuatini provisional application includes various subject matters describing different inventions and is over 500 pages long. Thus, Applicants' respectfully request that the Examiner particularly point out those portions of Tuatini's provisional application relied upon by the Examiner, as is required by 37 CFR 1.104(c)(2). It is not proper for the Examiner to simply refer to the lengthy and complex provisional application as a whole. **It is the Examiner who has the burden of proof to establish prior art.** The Examiner **must** point out the *particular parts* of the provisional application that support his rejection and that support the claims of the Tuatini published application. Until the Examiner has made this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

28

Section 103(a) Rejection:

The Office Action rejected claims 6-18, 56-67 and 104-112 under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Beck, et al. (U.S. Patent 6,604,140) (hereinafter "Beck"). Applicants respectfully traverse this rejection for at least the reasons given above in regard to the rejection of the independent claims.

Furthermore, regarding claim 8, contrary to the Examiner's assertion, **Tuatini in view of Beck fails to teach or suggest** wherein the advertisement includes information describing one or more computer programming language method calls to methods in the computer programming language provided by the second entity, the method further comprising constructing on the first entity a client method gate configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls.

The Examiner fails to cite any portion of either Tuatini or Beck describing constructing a client method gate on the first entity configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls described in the advertisement. The Examiner does not provide any remarks, arguments, nor does the Examiner even mention any interpretation of Tuatini in view of Beck that teaches or suggests construction of such a client method gate. Instead, the Examiner merely rejects claim 8 as part of a single rejection of claims 6-12, citing FIG. 1 and the Abstract of Beck and stating only that Beck "discloses the use of advertisement[s] (e.g. Middleware enables a device to discover, advertise and use services." Thus, the Examiner has not provided a proper rejection of claim 8.

Additionally, Tuatini and Beck, either separately or in any combination, fail to teach or suggest constructing a client method gate on the first entity configured to provide an interface to the second entity. Instead, as the Examiner admits, Tuatini fails to mention anything regarding service advertisements. Also, Tuatini fails to teach or

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

29

suggest constructing a client method gate. Beck teaches a system in which clients locate and use services based upon service descriptions in a service advertiser's registry (Beck, column 4, lines 31-39). However, Beck does not mention anything regarding a client constructing a client method gate configured to provide an interface to a service by generating data representation language messages including information representing the method calls described in an advertisement.

Thus, the Examiner's suggested combination of Tuatini and Beck fails to teach or suggest <u>constructing on the first entity a client method gate</u> configured to provide an interface to the second entity by generating data representation language messages including information representing the method calls. Instead Tuatini in view of Beck results in a system wherein the messaging component of Tuatini uses the service advertiser's registry of Beck to locate shared services.

For at least the reasons given above, the rejection of claim 8 is not supported by the cited prior art and removal thereof is respectfully requested. Remarks similar to those above regarding claim 8 also apply to claims 57 and 106.

Regarding claim 9, contrary to the Examiner's assertion, **Tuatini in view of Beck fails to teach or suggest** the first entity generating a method call in the computer programming language; the <u>client method gate generating a data representation language message including information representing the method call</u>; the client method gate sending the data representation language message to a proxy method gate comprised on the proxy service.

The Examiner does not cite any passage of either Tuatini or Beck that describes a client method gate generating a data representation language message including information representing a method call generated by a first entity. The Examiner, as noted above regarding claim 8, cites only Fig. 1 and the abstract of Beck. The Examiner argues that Beck "discloses the use of advertisement[s] (e.g. Middleware enables a device to discover, advertise and use services." However, the Examiner has failed to cite any

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

30

reference or to provide any arguments regarding a client method gate generating a data representation language message including information representing a method call generated by the first entity. Thus, the Examiner has failed to provide a proper rejection of claim 9.

Additionally, Tuatini in view of Beck clearly fails to teach or suggest a client method gate generating a data representation language message including information representing a method call generated by the first entity. Instead, Tuatini teaches only that a client desiring to access a set of functionality provided by a shared service send a message to a messaging component (Tuatini, paragraphs [0118] and [0129]). Tuatini does not mention anything about a client method gate generating such a message. Nor does Tuatini teach that the message includes information representing a method call generated by the client. Beck also fail to teach anything regarding a client method gate or about a client method gate generating a data representation language message including information representing a method call generated by a client. Thus, the combination of Tuatini in view of Beck also fails to teach or suggest such functionality. Instead the Examiner's suggested combination of Tuatini in view of Beck results in a system wherein the messaging component of Tuatini uses the service advertiser's registry of Beck to locate shared services.

Thus, for at least the reasons given above, the rejection of claim 9 is not supported by the prior art and its removal is respectfully requested. Remarks similar to those above regarding claim 8 also apply to claims 58 and 107.

Regarding claim 11, Tuatini in view of Beck does not teach or suggest a proxy service generating a results advertisement for the results data; the proxy service sending the result advertisement to the client method gate; and the first entity generating a results method gate from the results advertisement sent to the client method gate, contrary to the Examiner's contention.

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

31

The Examiner, has grouped claims 6-12 together in a single rejection without providing arguments, remarks or any cited references regarding claim 8. Thus, the Examiner has not cited any passage of Tuatini or Beck that teaches or suggests a proxy service generating a results advertisement for the results data; the proxy service sending the result advertisement to the client method gate; and the first entity generating a results method gate from the results advertisement sent to the client method gate. Instead, the Examiner only states that Beck "discloses the use of advertisement[s] (e.g. Middleware enables a device to discover, advertise and use services."

However, Beck does not teach anything regarding generating a results advertisement. Beck teaches service descriptors used to locate and user services (Beck, column 4, lines 31-60). Nowhere does Beck mention generating results advertisement, sending such a results advertisement to a client method gate or generating a results method gate from the results advertisement. As noted above, Tuatini is also silent regarding the generation and use of a results advertisement.

Furthermore, the Examiner's suggested combination of Tuatini and Beck does not result in a system that includes generating results advertisement, sending such a results advertisement to a client method gate or generating a results method gate from the results advertisement. Instead, modifying Tuatini in view of Beck, as suggested by the Examiner, results only in a system wherein the messaging component of Tuatini uses the service advertiser's registry of Beck to locate shared services.

Thus, for at least the reasons given above, the rejection of claim 11 is not supported by the prior art and its removal is respectfully requested. Remarks similar to those above regarding claim 8 also apply to claims 60 and 108.

The Office Action rejected claims 22, 71 and 115 under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Applicant's admitted prior art (hereinafter "AAPA").

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

32

Regarding claim 22, the Examiner stated that it would have been obvious to combine the teachings of Tuatini and the AAPA because the AAPA's use of Jini environment would provide access to the Jini services. Applicants disagree with the Examiner's statement. Applicants submit that such a broad conclusory statement, as made by the Examiner, does not provide a sufficient motivation to combine the teachings Tuatini and the AAPA. "The factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It must be based on objective evidence of record. "This precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). "A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). The Federal Circuit has stated: "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the [Examiner] must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the [Examiner] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *See also, In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

In the "Response to Arguments" section, the Examiner argues in response to the above remarks by citing long, boilerplate sections of both Tuatini and Applicants'

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

33

specification regarding alternative methods and embodiments for each respective invention. The Examiner also states, "[s]ince, applicant's claims contain broadly claimed subject matter it clearly reads upon the examiner's interpretation of these actions [i.e. the alternate embodiments from Applicants' specification]." However, the Examiner has still failed to provide any proper motivation for modifying Tuatini in view of AAPA. Instead the Examiner has merely pointed to standard boilerplate indicating that Tuatini's system may be modified, but that does not provide any motivation for the specify modification suggested by the Examiner. Similarly, nothing from AAPA mentions any benefit or suggestion to modify the teaching of Tuatini to include the Jini environment.

Just because the Jini environment was known in the prior art, does not mean that one of ordinary skill in the art would have been motivated to modify the teachings of Tuatini with the Jini environment. The Examiner has provided no objective evidence of record to the contrary. Applicants also respectfully remind the Examiner that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (M.P.E.P. § 2143.01, paragraph 8). The Examiner has only shown that both Tuatini and the Jini environment were known in the art. However, the Examiner's stated motivation, namely, "to utilize Jini services of the Jini environment so that a client will be able to acess [sic] advertisement related information from the remote servers of the Jini network through proxy services" amounts to nothing more than a conclusory statement based in hind-sight analysis of the present application.

In light of the above remarks, applicants assert that the rejection of claim 22 is not supported any evidence of record. Withdrawal of the rejection is respectfully requested. Similar remarks as discussed above in regard to claim 22 apply to claims 71 and 115.

Applicants also assert that numerous ones of the dependent claims recited further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

34

Information Disclosure Statement:

The Examiner has requested that Applicants submit all cited references listed on an previously submitted IDS dated August 16, 2001. However, these references have already been provided, as evidenced by the date-stamped return postcard from the original IDS submission (a copy of which is included herewith). To avoid undue repetition of the cost and effort involved in reproducing the numerous references, Applicants respectfully request that the Examiner attempt to locate the copies of the listed references that have already been submitted by Applicants.

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
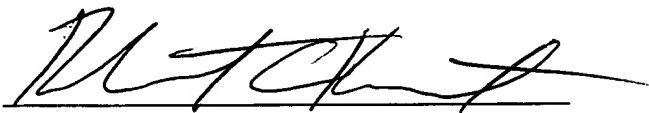
35

CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-72200/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Petition for Extension of Time

☐ Notice of Change of Address

☒ Copy of date-stamped return postcard from IDS of 8/16/2001

☐ Other:

Respectfully submitted,

Robert C. Kowert
Reg. No. 39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: ___March 7, 2005___

09/693,672 (5181-72200/P4987)   Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

36